

REMARKS

Claims 36-59 have been added. Claims 1-35 have been canceled.

Applicant notes that the claims have not been amended for reasons of patentability, but rather for clarity. In particular, as discussed in the prior Response of June 17, 2004, and as further discussed below, Applicant believes that canceled claims 1-35 are patentable over the references of record, including the references applied by the Examiner in this and the prior Office Action. Moreover, Applicant believes that the canceled claims are also patentable over the non-prior-art rejections made in the present Office Action, as discussed below in detail.

Applicant respectfully requests consideration of new claims 36-59 in view of the following remarks and in response to the accompanying Request for Continued Examination filed concurrently herewith.

Rejection under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 30-35 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner generally asserts that the step of "generating at least one invention map showing the at least one solution" is not described in a manner that would enable someone having ordinary skill in the art to make and use the claimed invention.

Claims 30-35 have been canceled. Therefore, the specific application of the present rejection is moot. That said, since this rejection pertains to the adequacy of the disclosure generally, Applicant will address this rejection.

Applicant respectfully disagrees with the Examiner that the step of generating an invention map is not enabled by the application as filed. FIG. 12 and accompanying description on pages 21 and 22 of the present application, respectively, illustrate and describe an example of an invention map of the present invention. Anyone having ordinary skill in the computer programming arts would readily understand, after reading the present application, how to generate such a map from the various sets of statements input by one or more participants and stored in a computer database in the manner disclosed. The law does not require applicants to describe matter relating to their inventions that is well-known in the relevant art(s). Consequently, Applicant asserts that a step of generating an invention map is indeed enabled by the present application as originally filed.

Accordingly, Applicant respectfully requests that the Examiner consider the foregoing when examining new claims 36-39, and particularly claims 37, 46 and 53 that each include limitations directed to generating an invention map.

Rejection under 35 U.S.C. § 112, Second Paragraph.

The Examiner has rejected claims 1-35 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. More particularly, the Examiner asserts that the Applicant has acted as his own lexicographer by using various claim terminology in a manner that is contrary to the ordinary meanings of such terminology. In this connection, the Examiner states that the Applicant did not clearly redefine the terminology at issue and asserts that, therefor, the claims are indefinite.

Claims 1-35 have been canceled. Therefore, the specific application of the present rejection is moot. That said, since the rejection applies to terminology used throughout the present application and the new claims, the rejection is still at issue.

The law does not require that claim terminology be construed relative to just any "plain" meaning, but rather the "ordinary and customary meaning given to the term by those of ordinary skill in the art." See, e.g., MPEP § 2111.01 (emphasis added). When terminology is used in this manner, i.e., consistently relative to the ordinary and customary meaning in the art, as in the present application, an applicant, *a fortiori*, does not need to explicitly define terminology for the simple reason than the applicant has not redefined the terminology.

In this connection, the Examiner has not cited the ordinary and customary meanings in the art of any of the terminology at issue. Rather, the Examiner has set forth no more than a series of questions, which appear to be requiring Applicant to provide the Examiner with a dictionary of the claim terminology at issue. Applicant asserts that it is not an applicant's burden to show that claim terminology is used in a manner consistent with the ordinary and customary meaning in the art. Rather, it is the Examiner's burden to show that an applicant has not used terminology in a consistent manner.

For example, section 706.03(d) of the MPEP states that form paragraph 7.34.02 should be used when making a rejection based on terminology being used inconsistently with its accepted meaning. Form paragraph 7.34.02 and excerpts from the corresponding Examiner Notes read as follows:

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. The term “[1]” in claim [2] is used by the claim to mean “[3]”, while the accepted meaning is “[4].” The term is indefinite because the specification does not clearly redefine the term.

Examiner Note:

1. In bracket 3, point out the meaning that is assigned to the term by applicant's claims, taking into account the entire disclosure.
2. In bracket 4, point out the accepted meaning of the term. Support for the examiner's stated accepted meaning should be provided through the citation of an appropriate reference source, e.g., textbook or dictionary.

MPEP § 706.03(d) (citation omitted) (emphasis added.). U.S. Patent and Trademark Office Rules clearly direct examiners to provide clear and specific evidence that claim terminology is being used inconsistently with plain meaning in the relevant art.

In both the present Office Action and the prior Office Action, the Examiner failed to include the sentence underlined in the above-quoted form paragraph. That is, the Examiner has not shown any evidence that Applicant's usage of the terminology at issue is, in fact, contrary to the ordinary and customary in the relevant art. Consequently, the Examiner has not met the requisite burden of showing the meaning of the terminology at issue in the context of the present claims and of showing the accepted meaning of the terminology in the relevant art, as required by the above-quoted examiner's notes 1 and 2, respectively. Applicant asserts that the Examiner must make these showings so that the Applicant can prepare a proper response to the rejection.

In the prior Response filed June 17, 2004, Applicant explained at a high level customary and ordinary meanings of the terminology at issue and provided evidence of customary and ordinary meanings of this terminology in the art of creative problem solving, even though Applicant was not required to do so, since the rejection was not clear. In response, the Examiner generally posed more open-ended questions, again without providing any evidence that the Applicant is using terminology in a manner inconsistent with its plain meaning. Again, a burden is improperly placed on Applicant because the Examiner has not provided any evidence that Applicant's use is, in fact, inconsistent with ordinary and customary meanings in the relevant art. Simply posing questions soliciting information about terminology is not evidence of inconsistent usage of that terminology.

Applicant asserts that the Examiner should have provided Applicant, and must provide in future Actions, with a detailed explanation of the Examiner's position on inconsistent usage using the above-cited form paragraph 7.34.02 in its entirety. This is so because § 707.07(f) of the MPEP states that:

[i]n order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of the application.

MPEP § 707.07(f) (emphasis added). Applicant believes that such a clear explanation includes explaining the rejection using the entire form paragraph 7.34.02 as set forth in MPEP § 706.03(d).

If the Examiner takes the position that any of the terminology of new claims is used contrary to accepted meanings, Applicant respectfully requests that the Examiner support her position using form paragraph 7.34.02 and include an instance of the sentence of form paragraph 7.34.02 underlined above for each term at issue.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-35 under 35 U.S.C. § 103 as being obvious in view of various combinations of U.S. Patent No. 6,101,490 to Hatton, U.S. Patent No. 5,662,478 to Smith and ordinary skill in the art.

While Applicant respectfully disagrees, the present rejection is moot because Applicant has canceled claims 1-35. However, these references are discussed below in the next section relative to the new claims.

Patentability of New Claims

Applicant asserts that the new claims 36-59 are patentable over the references of record, including the Hatton and Smith patents applied by the Examiner in the present Office Action.

Regarding the independent claims, independent claim 36 is directed to a method of facilitating conception of at least one invention. The method includes a number of steps in which specific information, e.g., mess statements, data statements, first problem statements, etc., directed particularly to the at least one invention is requested from at least one participant. Neither Hatton nor Smith, nor any other references of record, alone or in combination with one another, disclose these particular request steps..

Independent claim 38 is directed to a method of facilitating conception of at least one invention that includes instructing at least one participant of specific concepts and then requesting the at least one participant to input particular statements directed to these concepts. Neither Hatton nor Smith, nor any other references of record, alone or in combination with one another, disclose such instructing and requesting steps.

Independent claim 46 is directed to a computer-readable medium that contains computer executable instructions that generally perform the method of independent claim 36. Since neither Hatton nor Smith, nor any other references of record, alone or in combination with one another, disclose this method, as discussed above, *a fortiori*, neither Hatton nor Smith disclose a computer-readable medium that contains computer-executable instructions for performing this method. In addition, claim 46 requires that the computer-readable medium contain computer-executable instructions for creating an invention map of the present invention. Neither Hatton nor Smith, nor any other references of record, alone or in combination with one another, disclose such instructions.

Independent claim 52 is directed to a computer-readable medium that contains computer-executable instructions that provides a plurality of input fields and labels the input fields in a very specific way. Neither Hatton nor Smith, nor any other references of record, alone or in combination with one another, disclose such computer-executable instructions.

Independent claim 53 is directed to a system that includes a computer processor and a storage device essentially containing computer-executable instructions of independent claim 46. Since neither Hatton nor Smith, nor any other references of record, alone or in combination with one another, disclose the instructions of claim 46, *a fortiori*, neither discloses the claimed system is patentable over the references of record.

Independent claim 59 is directed to a system comprising a computer containing some of the computer-executable instructions of independent claim 52. Since neither Hatton nor Smith disclose these instructions, the claimed system is patentable over the references of record.

In addition to the independent claims, the dependent claims contain additional limitations not disclosed by Hatton or Smith, nor any other references of record, alone or in combination with one another. For example, neither Hatton nor Smith, nor any other references of record, alone or in combination with one another, disclose a step of, or computer-executable instructions for: 1) generating an invention map; 2) selecting by a facilitator of mess statements; 3) voting by

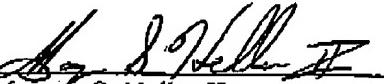
participants for mess statements; 4) soliciting from participants input of particular statements by email, among others.

For at least the foregoing reasons, Applicant asserts that new claims 36-59 are patentable over the references of record.

Conclusion

In view of the foregoing, Applicant respectfully submits that claims 36-59 are in condition for allowance. Therefore, prompt issuance of a Notice of Allowance is respectfully solicited. If any issues remain, the Examiner is encouraged to call the undersigned attorney at the number listed below.

Respectfully submitted,
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